

REMARKS

Claims 1-67 were pending prior to this response with claims 7-9, 16, 20-33 and 35-67 being withdrawn by the Examiner. By the present communication, claims 1 and 19 have been amended to define the invention with greater particularity. The amendments add no new matter, being fully supported by the specification and original claim, particularly by the description of the PEA polymer at paragraph [0062] of the application. No claims have been cancelled or added. Accordingly, upon entry of the amendments, claims 1-6, 10-15, 17-19, and 34 will be currently pending and under consideration.

The Inventorship

The Office Action indicates that inventorship in this application has been corrected by addition of Ramaz Katsarava as an inventor in compliance with 37 C.F.R. 1.48(a).

The Rejection under 35 U.S.C. § 112, Second Paragraph

Applicants respectfully contest the assertion in the Office Action that claim 19 is indefinite under 35 U.S.C. § 112, second paragraph, for allegedly failing to particularly claim the subject matter of the invention. In particular, Applicants disagree with the Examiner's assertion that use of the term "about" in claim 19 is indefinite because it is unclear as to the definitive upper and lower bound that can be defined. Applicants submit that use of the term "about" in claims has been interpreted in law to include the range of experimental error customary for the type of term used in the claim, in this case "angstroms."

However, to expedite prosecution and reduce the issues, claim 19 has been amended in the present communication to delete the term "about". Therefore, Applicants submit that claim 19, as currently amended, meets all requirements under 35 U.S.C. § 112, second paragraph, and withdrawal of the rejection thereunder is respectfully requested.

The Rejection under 35 U.S.C. § 103(a)

Applicants respectfully contest the assertion in the Office Action that claims 1-6, 10-16, 17-19, and 34 are unpatentable under 35 U.S.C. § 103(a) for allegedly being obvious over Chu et al. (WO 02/18477; hereinafter “Chu”) in view of Lang et al. (U.S. Patent No. 6,830,747; hereinafter “Lang”). However, the present application incorporates by reference the complete disclosure of U.S. Patent No. 6,503,538, which has a priority date of August 30, 2000. In addition, the present application incorporates a great deal of the disclosure of U.S. Patent No. 6,503,538. Therefore, Applicants respectfully submit that neither Chu nor Lang is available as prior art against the current claims under 35 U.S.C. § 103(a).

Accordingly, Applicants respectfully submit that claims 1-6, 10-15, 17-19, and 34 are patentable under 35 U.S.C. § 103(a) and reconsideration and withdrawal of the rejection of these claims over the combined disclosures of Chu and Lang is respectfully requested.

The Non-statutory Double Patenting Rejection

Applicants respectfully traverse the provisional rejection of claims 1-6, 10-11, 15, 17-19 and 34 for allegedly being obvious for non-statutory “obviousness type” Double Patenting over claims 1, 16-17 and 32 of co-pending US Application Serial No. 11/098,891, claims 1-6, 14, 25, 28-29, and 31 of co-pending US Application Serial No. 11/345,815, claims 1-6, 25, 27-29, and 31 of co-pending US Application Serial No. 11/128,903, and claims 1-6, 25, 27-29 and 31 of co-pending U.S. Application Serial No. 11/147,994 in view of Chu et al. Applicants respectfully submit that claims of the present application, as currently amended, distinguish over the claims of the Chu reference for the reasons presented above in response to the rejection under 35 U.S.C. § 103(a), which reasons are incorporated herein by reference.

The Examiner acknowledges in the Office Action (page 6) that the allegedly conflicting claims are “not identical” to the claims of the co-pending applications 11/098,891, 11/345,815, 11/128,903 and 11/147,994, but are “not patentably distinct from each other.”

A provisional rejection for non-statutory “obviousness type” Double Patenting can be overcome by Applicants filing a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) or

§ 1.321(d) provided the conflicting application is commonly owned with this application. According, Applicants herewith submit a Terminal Disclaimer showing that the present application and co-pending applications 11/098,891, 11/345,815, 11/128,903 and 11/147,993 are currently co-owned.

In view of the Terminal Disclaimer filed herein, Applicants respectfully submit that the provisional rejection of claims for allegedly being unpatentable under the judicially established doctrine of non-statutory double patenting over 11/098,891, 11/345,815, 11/128,903 and 11/147,993 in view of Chu is overcome. Accordingly, withdrawal of the rejection is respectfully requested.

In view of the above amendments and remarks and the Terminal Disclaimers presented herein, Applicants submit that all objections and rejections are now overcome, and passage of the claims to allowance is respectfully requested.

Conclusion

The Commissioner is hereby authorized to charge \$245.00 for a two-month extension of time and \$280.00 for four (4) terminal disclaimers filed (small entity). The Commissioner is also authorized to charge any additional outstanding fees that may be due in connection with the filing of this paper, or credit any overpayment to Deposit Account No. 07-1896, referencing the above-identified attorney docket number.

If the Examiner would like to discuss any of the issues raised in the Office Action, the Examiner is encouraged to call the undersigned so that a prompt disposition of this application can be achieved.

Respectfully submitted,



Antony M. Novom, J.D.
Registration No. 45,517
Telephone: (858) 638-6641
Facsimile: (858) 677-1465

DLA PIPER LLP (US)
4365 Executive Drive, Suite 1100
San Diego, California 92121-2133
USPTO CUSTOMER NO. 28213